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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,298	11/20/2003	Herman Rodriguez	AUS920030753US1	9781
45440	7590	12/27/2005	EXAMINER	
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			LE, DANH C	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/718,298	RODRIGUEZ ET AL
	Examiner DANH C. LE	Art Unit 2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 and 18-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-12,18,19,23-31,35-39 is/are rejected.
- 7) Claim(s) 3-5,20-22 and 32-34 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 11/20/03 and 2/27/04 have been considered by the examiner and made of record in the application file.

Election/Restrictions

2. Applicant's election without traverse of claims 1-12, 18-36 in the reply filed on 10/4/05 is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 6-12, 18, 19, 23-25, 30, 31, 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koster (US 6,253,081) in view of Mazzarella (US 6,819921).**

As to claim 1, Koster teaches a method for roaming (figure 3 and 5), comprising: receiving a request for roaming service from a wireless telephone within a roaming network, wherein the request comprises an identify of the wireless telephone and wherein the identity comprises a mobile identification number; determining that the identity is not stored as a record within the roaming network; offering a special roaming contract to a user of the wireless telephone; providing the special roaming contract to the user;

storing the identity and terms of the special roaming contract within the roaming network; and

providing roaming service for the wireless telephone pursuant to the special roaming contract.

Koster fails to teach the request including the ESN. Mazzarella teaches the request including the ESN (col.3, lines 42-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Mazzarella into the system of Koster in order to provide the security information in the requests.

As to claim 2, the combination of Koster and Mazzarella teaches the method of claim 1 (figure 3 and 5), further comprising:

providing an offer for the special roaming contract before the wireless telephone roams within the roaming network;

storing the mobile identification number within the roaming network.

As to claim 6, the combination of Koster and Mazzarella teaches the method of claim 2, after the step of storing the mobile identification number, the method further comprises:

determining that the roaming network contains the mobile identification number of the wireless telephone; and

storing the electronic serial number of the wireless telephone in the roaming network.

As to claims 7-12, the combination of Koster and Mazzarella fails to teach the offer for the special roaming contract is provided over a telephone, over the wireless telephone, over a personal computer, in person, through an interactive voice response system, the special roaming contract comprises contract roaming rates for the wireless telephone, providing default roaming services at a prevailing default roaming service rate and the renewal contract extends a contracted service term for a longer period. However, the examiner takes Official Notices that reciting limitations are known in the arts. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of reciting limitations into the system of Koster and Mazzarella in order to attract all customers.

As to claim 18, the claim is a software program of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 19, the claim is a software program of claim 2; therefore, the claim is interpreted and rejected as set forth as claim 2.

As to claim 23, the claim is a software program of claim 6; therefore, the claim is interpreted and rejected as set forth as claim 6.

As to claims 24-25, the claims are software program of claims 7-12; therefore, the claims are interpreted and rejected as set forth as claims 7-12.

As to claim 30, the claim is a system of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 31, the claim is a system of claim 2; therefore, the claim is interpreted and rejected as set forth as claim 2.

As to claim 35, the claim is a system of claim 6; therefore, the claim is interpreted and rejected as set forth as claim 6.

As to claims 36-39, the claims are system of claims 7-12; therefore, the claims are interpreted and rejected as set forth as claims 7-12.

Allowable Subject Matter

Claims 3-5, 20-22, 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claims 3, 20, 32, the teaching of prior arts above either alone or in combination fails to teach the method of claim 2, further comprising issuing a contract code to the user, wherein the contract code identifies the special roaming contract and storing the contract code associated with the mobile identification number within the roaming network.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Benco et al (US 2005/0043012) teaches method for displaying roaming charge rate on mobile station.
- B. Kikinis (US 2003/0083991) teaches method and apparatus for tracking and billing cellular roaming charges via a data packet network.
- C. Tiedemann, Jr. et al (US 5,862,471) teaches method and apparatus for providing roaming indication with charge information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



December 21, 2005.

DANH CONG LE
PATENT EXAMINER